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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Meng-Ling Hsiao

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EXAMINER

COBY, FRANTZ

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,257

Applicant(s)

HSIAO ET AL.

Examiner

Frantz Coby

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2161

This is in response to Applicant's amendment filed on July 26, 2004 in which claims 1, 11, 15, 20, 26-27 and 29-33 are presented for examination.

Status of Claims

Claims 1-9 and 11-33 are pending.

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Therefore the rejection of claims 1-33 under section 103(a) mailed on May 03, 2004 remains.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2161

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 11-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vellandi U.S. Patent no. 6,385,614.

As per claim 1, Vellandi discloses the invention including "a method for controlling online access to reference materials" by providing a shared electronic book, which multiple users each have, the right to access the book but only one of the users is allowed to actually access the book at a given point in time (See Vellandi Abstract). In particular, Vellandi discloses the claimed limitations "receiving an online request for a reference material" as a subscriber using the subscriber computer 14 to communicate a request (See Vellandi Col. 6, lines 18-36). Also, Vellandi discloses the claimed feature "providing access to the copy of the requested material if the requested reference material is available" as a book -not presently allocated to another subscriber where the server 12 conveys a message to the subscriber computer 14 via the Internet system 16 that the subscriber has been granted exclusive access to the book (See Vellandi Col. 6, lines 33-43). Further, Vellandi discloses the claimed feature of "determining if a user has possession of a token corresponding to the requested reference materials" as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33). Last, Vellandi discloses the claimed feature of "passing a token to a requester of the online request if a copy of the requested material is

Art Unit: 2161

available such that the server no longer has the possession of the token to provide access to the copy of the requested reference material to another requester while the requester has the possession of the token passed from the server;" as a subscriber that uses the subscriber's computer 14 to communicate a request which includes a cookie to the server for access to a particular shared book (See Vellandi Col. 6, lines 33-36).

It is noted that although Vellandi specifically detailed the aspect of providing access to a book only if the book is available (not presently allocated to another subscriber) and denying access to a subscriber when the server does not receive a request with the noted cookie from the subscriber within a predetermined period of time, Vellandi did not specifically recite the claimed limitation of "temporarily denying access to the requested reference material if the requested reference material is not available" as recited in the instant claim 1 . However, one of ordinary skill in the art at the time of the invention would have found it obvious that the aspect of "temporarily denying access to the requested reference material if the requested reference material is not available" would have occurred in the system of Vellandi whenever a book is presently allocated to another subscriber. The motivation being, to permit the owner of the electronic book to control access to the book more efficiently.

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature "transmitting the copy of the requested reference material as a digital electronic file" by providing individuals access to an

Art Unit: 2161

electronic book (col. 1, lines 46-47) where a copy of the electronic book is transmitted to the subscriber's computer 14 when the electronic book is available.

As per claims 3-4, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses "a client side agent to the requester, the client side agent being programmed to transmit an indication to a server hosting the requested reference material when the transmitted copy of the requested reference material has been replaced" through a browser program on the subscriber computers (Figure 1, component 14). Although Vellandi discloses transmission of a book from the server to a user; It is noted that Vellandi did not specifically describe the aspect of "transmitting the copy of the requested material as HTML". However, Vellandi discloses mechanism to communicate electronic book through the World Wide Web. One of ordinary skill in the art at the time of the invention would have found it obvious to have the electronic book of Vellandi being communicate as HTML since the layout language for the World Wide Web or Web documents is Hypertext Markup Language and web documents are stored in HTML format in association with server software or remote software.

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature "receiving an indication when access to

Art Unit: 2161

the copy of the requested material is terminated" by permitting termination of a subscriber's access to a book upon expiration of the predetermined period (See Vellandi Col. 6, line 59-co1 .7, line 2).

As per claim 6, most of the limitations of this claim 'have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "receiving an indication in the form of a return of the token from the requester when access to the copy of the requested material is terminated, wherein the returned token is subsequently assigned to another requester requesting the requested reference material " by providing mechanism for allowing a cookie to be returned before the predetermined period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book (See Vellandi Col. 2, lines 29-63., col. 1, lines 51-60).

As per claims 7-8, most of the limitations of these claims have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses "monitoring a client side browser by an application of the requester to determine the client side browser has been for a prescribed period of time and to determine when an image of the requested reference material has been replaced', and receiving the token back from application of the requester when the image of the requested reference material has been replaced, wherein the received token is used to determine whether the requested reference material can be accessed

Art Unit: 2161

by another requester" by providing users access to the share electronic book for a predetermined period of time in which the client's browser is monitored (See Vellandi Col. 2, line 29-col. 3, line 18).

As per claim 9, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "Comparing a number of copies of the requested reference materials to which access is currently being provided with a maximum number of copies of the requested reference materials for which access can contractually be provided" by providing a counter which when equal to 1 determines whether a book is available to be transmitted to a subscriber through a process that compares a number of copies of the requested book to which access is currently being provided with a maximum number of copies of books (See Fig. 6., Col. 9, lines 10-29).

As per claim 11, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed features of --providing view access or denying view access to the requested reference material- by providing mechanism for allowing a subscriber to view a selected book (See Vellandi Fig. 213., Col. 6, lines 11-17., col. 5, lines 45-48).

As per claim 12, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "receiving an indication from a client side agent at the requester in the form of a return of a token when the copy of the requested material has been replaced in a client side browser, wherein the client side agent actively monitors the access of the requested reference material by the requester" by providing mechanism for allowing a cookie to be returned before the predetermined period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book or for the cookie to be transmitted to another user who wants to access the electronic book (See Vellandi Col. 2, lines 29-63., col. 1, lines 51-60). Notice that the subscriber computers 14 each include a web browser (See Vellandi Col. 5, lines 44-47).

As per claim 13, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses "transmitting a client side agent from a server; the client side agent being executable at the client to monitor activities of the client regarding accessing the requested reference material" as transmitting a cookie to the requested subscriber and "receiving an indication from the client side agent when the copy of the requested reference material has been replaced in a client side browser, wherein the indication includes the token previously sent to the client to enable the server to allow

access to the requested reference material by another subsequently" (See Vellandi Col. 6, lines 18-58).

As per claim 14, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

As per claim 15, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. Regarding the claimed feature of "determining if the requested reference material is made available on limited basis or on an unlimited basis" Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanisms for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 16, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, Vellandi discloses the claimed feature of "determining whether a server has

Art Unit: 2161

possession of a token corresponding to the requested reference materials" as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33). Notice that in Vellandi the server always maintains possession of the cookie and release it when a subscriber makes a request.

As per claim 17, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, as to the claimed feature of transmitting "a computer readable copy of the requested material to a requester's computer" Vellandi achieved that since Vellandi's method is being implemented in a network of computers (See Vellandi Figure 1).

As per claim 18, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, Vellandi discloses the claimed feature of "receiving an indication from the requester when the requester has finished accessing the requested material, the indication including the token previously sent to the requester when requesting the requested material, and wherein the token enables the requested reference material to be accessed by another requester" as a cookie which is returned to the server as an indication that the requester has finished accessing the requested material (See Vellandi Col. 1, line 64-Col. 2, line 5).

As per claim 19, most of the limitations of this claim have been noted in the rejection of claim 1 . Applicant s attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "passing possession of a token corresponding to the requested reference material from a server to the requester each time that on-line access to the requested material for the requester is provided if the requested material is made available on a limited basis', receiving an indication in the form of a return of the token corresponding to the requested reference material each time the requester has finished accessing the requested material (See Vellandi Col. 1, line 51-Col. 2, line 28).

As per claim 20-24, most of the limitations of these claims have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above.

Regarding the claimed feature of --providing limited access and unlimited access collection of reference material- Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10). As to the claimed feature of "allowing only a central authority, to update the limited access collection of reference material" this can be achieved by the system administrator through the Internet Server Provider

Art Unit: 2161

(See Vellandi Col. 5, lines 57-60). It is noted however, Vellandi did allow users to update unlimited access collection of reference materials as recited in the instant claim 20. However, the Examiner takes official notice that allowing users to update a reference is well known in the art.

As per claim 25, most of the limitations of these claims have been noted in the rejection of claim 20. Applicant's attention is directed to the rejection of claim 20 above. In addition, Vellandi discloses a user interface as L'O interface 18 and 110 interface 20 (See Vellandi figure 1).

As per claim 26, most of the limitations of this claim have been noted in the rejection of claim 20. Applicant's attention is directed to the rejection of claim 20 above. Regarding the claimed feature of "determining if the requested reference material is made available on limited basis or on an unlimited basis" Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A, Col. 6, lines 1-10).

As per claim 27, most of the limitations of these claims have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above. Ln

Art Unit: 2161

addition, Vellandi discloses an interface as 1 10 interface 18 and 1/0 interface 20 (See Vellandi figure 1). A "processor programmed" primarily incorporated in the computer network of figure 1 . Regarding the claimed feature of determining if the requested reference material is made available on limited basis or on an unlimited basis- Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that her/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 28, most of the limitations of this claim have been noted in the rejection of claim 27. Applicant's attention is directed to the rejection of claim 27 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

As per claim 29, all the limitations of this claim have been noted in the rejection of claim 27. It is therefore rejected as set forth above.

As per claim 30, all the limitations of this claim', have been noted in the rejection of claim 1. It is therefore rejected as set forth above.

As per claim 31, all the limitations of this claim have been noted in the rejection of claim 11 . It is therefore rejected as set forth above.

As per claim 32, all the limitations of this claim have been noted in the rejection of claim 15. It is therefore rejected as set forth above.

As per claim 33, all the limitations of this claim have been noted in the rejection of claim 20. It is therefore rejected as set forth above.

Remarks

The Applicant argued, "Vellandi fails to disclose or suggest the limitations set forth above. One with ordinary skill in the art, based on the teachings of Vellandi, would not be able to arrive the present invention as claimed. Such a suggestion can only be found in Applicant's own disclosure. It is respectfully submitted that it would be impermissible hindsight to use Applicant's disclosure against the Applicant. A cookie is not the same as a token. A cookie and a token have significant different meanings in the networking industry. A cookie is a message given to a Web browser by a Web server. The browser stores the message in a text file. The message is then sent back to the server each time the browser requests a page from the server. The main purpose of cookies is to identify users and possibly prepare customized Web pages for them. For example, when a user enters a Web site using cookies, the user may be asked to

Art Unit: 2161

fill out a form providing such information as the name and interest. This information is packaged into a cookie and sent to the user's Web browser, which stores it for later use. The next time the user goes to the same Web site, the user's browser will send the cookie to the Web server. The server can use this information to present the user with custom Web pages. Each client has a cookie having specific information regarding the client's interest. However, a token is a special series of bits that travels around a network. The token acts like a ticket or permission enabling its owner to send a message across the network. There is only one token for each network shared by multiple clients, contrary to the cookies of each of the clients. The fact that a cookie is transmitted to a client after verifying the username and password of the client is irrelevant with respect to determining if a server has the possession of a token corresponding to the requested reference materials. After the server of Vellandi authenticates the client, a cookie is transmitted from the server to the client, regardless whether the client requests for a reference material. The cookie is transmitted to the client even before the client requests the reference material. Thus, the cookie transmitted to the client is not associated with a particular reference material, contrary to the present invention as claimed". The Examiner respectfully submits that a cookie, as used in the Vellandi Patent is not for the purpose explained, by the Applicant, above; instead, in Vellandi, a cookie is used to determine whether a person/user has possession of a copy of a book/material in a computer network or a server. Therefore, the Applicant's argument is mute.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, especially Applicant's argument that "one with ordinary skill in the art, based on the teachings of Vellandi, would not be able to arrive the present invention as claimed. Such a suggestion can only be found in Applicant's own disclosure. It is respectfully submitted that it would be impermissible hindsight to use Applicant's disclosure against the Applicant". It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272 4017. The examiner can normally be reached on Monday-Saturday 3:00PM-10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571 272 4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frantz Coby
Primary Examiner
Art Unit 2161

January 19, 2005